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Simona Lebok

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EXAMINER

ELLIS, SUEZU Y

ART UNIT

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1615

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/525,637

Applicant(s)

LEBOK ET AL.

Examiner

Suezu Ellis

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/18/05,  
9 10/11/06, 11/7/06, 12/18/06, 4/10/07.

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 18, 2005, September 11, 2006, November 7, 2006, December 18, 2006 and April 10, 2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

With respect to claim 74, the specification does not clearly describe nor appear to provide support with respect to a process that forms a lead by casting and also casts into a rotary mechanism. According to the specification, it appears these are two separate and unrelated processes.

With respect to claim 75, the specification describes a process where a lead is formed by casting and then glued into wood. However the specification does not clearly

describe, nor appears to provide support with respect to a process that does both casting a lead and also casting into wood.

### ***Claim Objections***

Claim 37, 40 and 73 are objected to because of the following informalities:

With respect to claim 37, claim language recites in line 3, "hydrated vegetable oils". It appears from the dependent claims, "hydrated" should be "hydrogenated".

In claim 40, line 3, it appears "canauba" is misspelled. According to Wikipedia, the correct spelling is "carnauba".

With respect to claim 73, claim language recites "wherein a preparation including shaping the preparation by casting to form a lead and further processed to form a pencil". The wording is awkward.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 74 and 75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to claim 74, applicant's specification is enabling for the process of casting to form a lead and further processing to form a pencil (claim 73). It appears from applicant's specification that casting into a rotary mechanism is another process, unrelated to the process in claim 73. However there does not appear to be support to enable one of ordinary skill in the art to then perform casting into a rotary mechanism.

With respect to claim 75, applicant's specification is enabling for the process of casting to form a lead and further processing to form a pencil (claim 73). According to paragraph [0031], the lead is formed by casting and then glued into wood. However there does not appear to be support to enable one of ordinary skill in the art to form a lead via casting and then perform casting into wood.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 43, 46, 55-58, 64-67, 70, 74 and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 43 and 46, it is not explicitly clear if applicant is referring to the oil phase to be a mixture of vegetable waxes and hydrogenated vegetable oils since this particular mixture is not required in claims 37 and 42. Please clarify.

With respect to claims 55-57, claim language recites "the amount of organic and inorganic pigments are...". Claim 51 recites "the solid phase is selected from the group consisting of fillers, organic pigments, inorganic pigments, and mixtures thereof". Therefore, it is not explicitly clear in claims 55-57 if applicant is referring to the solid phase being a mixture having both organic and inorganic pigments, since it is not required in claim 51. If applicant is referring to a mixture, it is unclear if the range is for the entire mixture of pigments, or for individual organic and inorganic pigment (e.g. the amount of organic pigments are in a range between 1 and 50% by weight with respect to the total weight of the preparation and the amount of inorganic pigments are in a range between 1 and 50% by weight with respect to the total weight of the preparation, or the total amount of combined organic and inorganic pigments are in a range between 1 and 50% by weight with respect to the total weight of the preparation). Please clarify.

In claim 64, claim language in line 2, recites "further comprising, as preserving agent". It appears claim language should recite "a preserving agent" or "as a preserving agent", instead of "as preserving agent", for proper grammar. However, it is unclear if applicant intended the claim language to recite the lipid-preparation further comprising a preserving agent and at least one of vegetable-based preserving agents, natural perfumes, perfumes which are identical to nature and mixtures thereof, or if applicant intended the claim language to recite the lipid-preparation further comprising, as a preserving agent, at least one of vegetable-based preserving agents, natural perfumes, perfumes which are identical to nature and mixtures thereof. Please clarify. Also, claim language in lines 3-4 recite "perfumes which are identical to nature". It is unclear what

applicant means by perfumes being identical to nature. It is also unclear how this differs from the "natural perfumes" listed prior to. Please clarify. For examination purposes, claim language will be interpreted as the lipid-preparation further comprising, as a preserving agent, at least one of vegetable-based preserving agents, natural perfumes, perfumes which are identical to nature and mixtures thereof.

With respect to claim 70, it is unclear what a "rotary spindle mechanism" is. Please clarify.

With respect to claim 74, it is unclear how the step of casting into a rotary mechanism is related to the process in claim 73 (casting to form a lead and further processing to form a pencil). The step in claim 74 appears to be a separate and unrelated to the process in claim 73. According to Merriam-Webster Dictionary Online, casting is defined as "to give a shape to (a substance) by pouring in liquid or plastic form into a mold and letting harden without pressure". It is unclear if the lead is first formed via casting and then re-casted into a rotary mechanism by the process described in the dictionary. When is the casting into a rotary mechanism performed? Please clarify. Since the scope of the claim is so unclear, the claim will not be treated on the merits.

With respect to claim 75, it is unclear how the step of casting into wood, glued and processed to form a pencil is related to the process in claim 73 (casting to form a lead and further processing to form a pencil). The step in claim 75 appears to be a process separate than that in claim 73. It is unclear if the lead is first formed via casting and then casted into wood, glued and processed to form a pencil. According to



Merriam-Webster Dictionary Online, casting is defined as “to give a shape to (a substance) by pouring in liquid or plastic form into a mold and letting harden without pressure”. Therefore, it is unclear that if the lead is already casted, it is then recasted, by the process described in the dictionary, into wood, glued and processed to form a pencil. Please clarify. Since the scope of the claim is so unclear, the claim will not be treated on the merits.

Claims not specifically addressed are indefinite due to their dependency.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36, 37, 40-42, 44, 45, 51, 53 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Mattin (GB 1,134,170).

With respect to claims 36, 37, 40, 51 and 63, Mattin discloses a lipid-bearing preparation for cosmetic uses (lipstick), comprising an oil phase and a solid phase (pigment), wherein the oil phase comprises a mixture of vegetable-base raw materials (candelilla wax and castor oil) (Example 13), wherein the vegetable-base raw materials are a mixture of vegetable oil and vegetable wax.

With respect to claims 41 and 44, Mattin discloses in Example 13, the vegetable oil (castor oil) being in the range of 5-45% by weight with respect to the total weight of the preparation.

With respect to claims 42 and 45, Mattin discloses in Example 13, the vegetable wax (candelilla wax) being in the range of 1-20% by weight with respect to the total weight of the preparation.

With respect to claim 53, Mattin discloses in Example 13, the inorganic pigments selected from a group consisting of bismuth oxide chloride (pg. 2, lines 5-9). Mattin also discloses a lipid-bearing preparation can comprise mica coated with titanium dioxide (pg. 2, lines 9-10).

Claims 36-38, 40-42, 44, 45, 51, 53, 55, 56, 63, 68-70 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Lebok et al. (US 6,277,182).

With respect to claims 36, 37, 51 and 63, Lebok et al. discloses a lipid-bearing preparation for cosmetic uses (eyeshadow, lipliner), comprising an oil phase, and a solid phase (pigment) (col. 3, lines 61-62), wherein the oil phase comprises a mixture of vegetable-base raw materials, wherein the vegetable-base raw materials are selected from the group consisting of vegetable oils, hydrogenated vegetable oils, vegetable waxes, and mixtures thereof (col. 3, lines 25-26, 40-42, 36-37; Examples 2 and 3).

With respect to claims 38 and 40, Lebok et al. discloses the vegetable oil being selected from the group consisting of jojoba oil (col. 4, lines 20, 38-40; col. 4, line 66 -

col. 5, line 12; Example 2), and the wax(es) selected from the group consisting of candelilla and/or carnauba (col. 3, lines 40-42; Example 2).

With respect to claims 41 and 44, Lebok et al. discloses in Example 2, the content of vegetable oils is 29% by weight with respect to the total weight of the preparation.

With respect to claims 42 and 45, Lebok et al. discloses the content of vegetable waxes in a range of between 0.1 to 25% by weight with respect to the total preparation (col. 3, lines 56-57), and illustrates in Example 2, the content of vegetable waxes is 2% by weight with respect to the total preparation.

With respect to claim 53, Lebok et al. discloses the inorganic pigments are selected from the group consisting of titanium dioxide, zinc oxide and iron oxides (col. 3, lines 61-62).

With respect to claims 55 and 56, Lebok et al. discloses the amount of organic and inorganic pigments are in a range between 5 and 30% by weight with respect to the total weight of the preparation (col. 4, lines 4-5).

With respect to claims 68, Lebok et al. discloses the preparation is in the form of a stick (shape of lipliner) glued into sleeve banks (col. 6, lines 19-21). Lebok et al. also discloses the sleeve banks made of wood (col. 4, lines 33-34).

With respect to claim 69, Lebok et al. discloses the preparation is in the form of a cast into a sleeve bank (col. 4, lines 59-60) and further discloses the sleeve bank made of plastic (col. 4, lines 33-34).

With respect to claim 70, Lebok et al. discloses the preparation is in the form of a stick and is cast into a rotary spindle mechanism (casting mold mounted on rotary mechanism) (col. 4, lines 60-61).

With respect to claim 73, Lebok et al. discloses a method of producing a cosmetic pencil wherein the preparation is shaped by forming a lead by casting and the lead is further processed to form a pencil (col. 5, lines 1-10).

Claims 36-40, 42, 43, 47, 51, 53, 55, 63 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Calello et al. (US 6,086,859).

With respect to claims 36, 37, 51 and 63, Calello et al. discloses a lipid-bearing preparation for cosmetic uses (lipstick) (col. 1, lines 62-65), comprising an oil phase, and a solid phase (pigment) (col. 2, lines 45-58), wherein the oil phase comprises a mixture of vegetable-base raw materials, wherein the vegetable-base raw materials are selected from the group consisting of vegetable oils, hydrogenated vegetable oils, vegetable waxes, and mixtures thereof (col. 3, lines 50-51, col. 4, lines 66-67).

With respect to claim 38, 39 and 47, Calello et al. discloses the mixture of oils includes hydrogenated jojoba oil and meadowfoam seed oil (col. 4, lines 20, 38-40; col. 4, line 66 - col. 5, line 12).

With respect to claim 40, Calello et al. discloses the wax can be candelilla or carnauba (col. 4, lines 66-67).

With respect to claims 42 and 43, Calello et al. discloses the content of vegetable waxes (hydrogenated jojoba oil) is in a range of 10-30% (col. 4, line 60 - col. 5, line 1)

With respect to claims 53 and 55, Calello et al. discloses the pigment comprising of organic and inorganic pigments (chromium hydroxide) (col. 2, lines 13-14, 20-22), where the pigment is 1-25% by weight with respect to the total weight of the preparation (col. 2, lines 10-14).

With respect to claim 76, Calello et al. discloses a storage stable cosmetic mass (col. 1, lines 62-65), comprising a combination of oil and waxes (col. 2, lines 45-58). oil is meadowfoam seed oil and the wax is hydrogenated jojoba oil (col. 4, lines 20, 38-40; col. 4, line 66 - col. 5, line 12).

Claims 36-38, 41, 42, 44, 45, 51-56 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Koulbanis et al. (US 4,437,895).

With respect to claims 36, 37, 51 and 63, Koulbanis et al. discloses a lipid-bearing preparation for cosmetic uses (col. 4, lines 47-49; col. 6, line 29), comprising an oil phase, and a solid phase (inorganic and organic pigments) (col. 3, lines 46-50), wherein the oil phase comprises a mixture of vegetable-base raw materials, wherein the vegetable-base raw materials are selected from the group consisting of vegetable oils (Example 11) or from the group consisting of a mixture of vegetable oil and vegetable wax (Example 6).

With respect to claim 38, Koulbanis et al. discloses in Example 11, the vegetable oils are selected from the group consisting of a mixture of mango seed oil and jojoba oil.

With respect to claims 41, 42, 44 and 45, Koulbanis et al. discloses in Example 6, the content of the vegetable wax (coffee bean wax) is 4.5% by weight and the content of

the vegetable oil (jojoba oil) is 10.5% by weight with respect to the total weight of the preparation.

With respect to claim 52, Koulbanis et al. discloses the fillers being selected from the group consisting of talc or kaolin (col. 3, lines 46-48).

With respect to claims 53 and 54, Koulbanis et al. discloses in Example 11, the inclusion of inorganic pigments selected from the group consisting of titanium dioxide and iron oxides, and the organic pigments selected from the group consisting of lakings of organic coloring agents with calcium (D and C Red 7, calcium lake).

With respect to claims 55 and 56, Koulbanis et al. discloses in Example 11, the combined amount of organic (D and C Red 7, calcium lake) and inorganic pigments (titanium dioxide, titanium mica, iron oxides) is 8.3% by weight with respect to the total weight of the preparation.

Claims 36-38, 41, 42, 44, 45, 51-54 and 63-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonda et al. (US 6,355,261).

With respect to claims 36, 37 and 63, Bonda et al. discloses a lipid-bearing preparation for cosmetic uses (lipstick), comprising an oil phase, and a solid phase (colorants) (col. 11, lines 54-59), wherein the oil phase comprises a mixture of vegetable-base raw materials (emollients and waxes), wherein the vegetable-base raw materials are selected from the group consisting of a mixture of vegetable oil and vegetable wax (Classic Lipstick table in col. 11; col. 11, lines 39-48; Example 3).

With respect to claim 38, Bonda et al. discloses the vegetable oils are selected from the group consisting of meadowfoam seed oil and jojoba oil (col. 11, lines 39-44).

With respect to claims 41, 42, and 45, Bonda et al. discloses the content of the vegetable wax is 8-13% by weight and the content of the vegetable oil (emollient) is 40-55% by weight with respect to the total weight of the preparation (Classic Lipstick table in col. 11).

With respect to claim 44, Bonda et al. discloses the vegetable wax is 8.6% by weight and the vegetable oil is 41% by weight with respect to the total weight of the preparation (Example 3).

With respect to claim 52, Bonda et al. discloses the fillers are selected from the group consisting of starch (col. 11, line 66 - col. 12, line 2).

With respect to claims 53 and 54, Bonda et al. discloses the inclusion of inorganic pigments selected from the group consisting of titanium dioxide, zinc oxide or iron oxides, and the inclusion of organic pigments selected from the group consisting of lakings of organic coloring agents with aluminum or barium (col. 11, lines 54-59).

With respect to claims 64-66, Bonda et al. discloses using rosemary extract as a preserving agent (col. 12, lines 3-4), and the preserving agent being about 0.5% by weight with respect to the total weight of the preparation (Classic Lipstick table in col. 11).

Claims 36, 37, 51, 53, 55, 58-60, 63, 64 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al. (US 5,560,917).

With respect to claims 36, 37, 51 and 63, Cohen et al. discloses a lipid-bearing preparation for cosmetic uses (col. 3, lines 58-60), comprising an oil phase (oils) and a solid phase (organic and inorganic pigments) (col. 4, lines 10-24), wherein the oil phase comprises a mixture of vegetable-base raw materials, wherein the vegetable-base raw materials are selected from the group consisting of vegetable oils (macadamia nut oil and kukui nut oil) (col. 6, lines 4-5, 8-9).

With respect to claim 53, Cohen et al. discloses the inorganic pigments are selected from the group consisting of titanium dioxide (col. 4, lines 20-14).

With respect to claim 55, Cohen et al. discloses the amount of organic and inorganic pigments are in a range of between 1 and 50% by weight with respect to the total weight of the preparation (col. 5, lines 10-11).

With respect to claim 58, Cohen et al. discloses the pigments have particle sizes in the range of between 5 and 25 nm (col. 4, lines 36-38).

With respect to claims 59 and 60, Cohen discloses the titanium oxide, used as a light protection agent, are nanopigments in an amount of between 5 and 15% by weight with respect to the total weight of the preparation (col. 4, lines 36-38; col. 5, lines 10-11).

With respect to claims 64 and 65, Cohen et al. discloses using a natural perfume (cedar oil) as a preserving agent (col. 7, lines 37-39), and the preserving agent being about 0.25-0.75% by weight with respect to the total weight of the preparation (col. 7, lines 46-47).



Claims 36-40, 51-53, 55 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Marchi-Lemann et al. (US 6,004,567).

With respect to claims 36, 37 and 63, Marchi-Lemann et al. discloses a lipid-bearing preparation for cosmetic uses (col. 6, lines 11-15), comprising an oil phase (oils and/or waxes) and a solid phase (nanopigment particles, fillers), wherein the oil phase comprises a mixture of vegetable-base raw materials, selected from vegetable oils, hydrogenated vegetable oils, vegetable waxes and mixtures thereof (col. 2, lines 6-9; col. 3, lines 39-41; col. 4, lines 49-50, 60-62).

With respect to claims 38 and 40, Marchi-Lemann et al. discloses the vegetable-base raw materials are selected from the group consisting of jojoba oil and the vegetable waxes are selected from the group consisting of carnauba wax and candelilla wax (col. 3, lines 48-49, 65-66).

With respect to claim 39, Marchi-Lemann et al. discloses the hydrogenated vegetable oils are selected from the group consisting hydrogenated castor oil (col. 4, lines 60-62).

With respect to claims 51 and 52, Marchi-Lemann et al. discloses the solid phase selected from the group consisting of fillers, wherein the filler is selected from the group consisting of talc or nylon powder (col. 3, lines 31-38).

With respect to claim 51 and 53, Marchi-Lemann et al. discloses the solid phase selected from the group consisting of inorganic pigments, wherein the inorganic pigments are selected from the group consisting of titanium dioxide, zinc oxide or bismuth oxychloride (col. 3, lines 21-24).

With respect to claim 55, Marchi-Lemann et al. discloses the amount of organic and inorganic pigments are in a range of between 1 and 50% by weight with respect to the total weight of the preparation (col. 2, line 6; col. 4, lines 30-34).

Claims 36, 37, 40, 51, 54 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Papantoniou et al. (US 3,937,811).

With respect to claims 36, 37, and 63, Papantoniou et al. discloses a lipid-bearing preparation for cosmetic uses (lip rouge) comprising an oil phase and a solid phase (dyes), where in the oil phase comprises a mixture of vegetable-base raw materials, wherein the vegetable-base raw materials are a mixture of vegetable oils and vegetable waxes or a mixture of vegetable waxes (col.3, lines 17-18, 33-37; col. 5, lines 38-40).

With respect to claim 40, Papantoniou et al. discloses the vegetable waxes are selected from the group consisting of candelilla wax and carnauba wax (col. 3, lines 21-22).

With respect to claim 51 and 54, Papantoniou et al. discloses the dyes (pigments) are selected from the group consisting of lakings of organic colorings agents with aluminum, barium, calcium, and zirconium (col. 6, lines 3-9).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46, 48-50, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calello et al. in view of Johnson ("What's that stuff? Lipstick" article).

With respect to claim 46, Calello et al. discloses the content of vegetable waxes (hydrogenated jojoba oil) is in a range of 10-30% (col. 4, lines 60 - col. 5, line 1). While it is possible for the ranges of the vegetable wax to be in the range as claimed, Calello fails to expressly disclose an example demonstrating the percentage being in the claimed range. Johnson discloses the waxes are related to the shape and ease of application of lipsticks (pg. 2, paragraph starting with "Lipsticks contains a variety of..."). It would have been obvious to one of ordinary skill in the art to modify the amount of vegetable wax in order to obtain the best/desired results (e.g. shape of lipstick, ease of application). Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

With respect to claims 48-50, Calello et al. addresses all the limitations of claims 36 and 47, and further discloses the hydrogenated jojoba oil is in a range of 3-40% by weight, and more preferably 10-30% by weight, and the meadowfoam seed oil is in a range of 5-85% by weight, and more preferably 20-75% by weight (col. 3, lines 23-28; col. 4, lines 60-63). While it is possible for the ranges of the vegetable-base raw materials to be in the ranges as claimed, Calello fails to expressly disclose an example

demonstrating the percentages being in the claimed ranges. Johnson discloses that the oils and waxes are related to the ease of application, shine and shape of lipsticks (pg. 2, paragraph starting with "Lipstick contains a variety of..."). It would have been obvious to one of ordinary skill in the art to modify the amount of vegetable-base raw materials in order to obtain the best/desired results (e.g. shape of lipstick, ease of application, shine, etc.). Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

With respect to claims 56 and 57, Calello et al. addresses all the limitations of claims 36 and 51, and further discloses the amount of organic and inorganic pigments are in a range of between 1-25% by weight with respect to the total weight of the preparation (col. 2, lines 10-14). While it is possible for the range of the pigments to be in the range as claimed, Calello fails to expressly disclose an example demonstrating the percentages being in the claimed ranges. Johnson discloses the amount of pigment is related to the shade of color of lipsticks (pg. 2, paragraph starting with "Lipsticks gets it color from..."; pg. 3, paragraph starting with "Matte lipsticks..."). It would have been obvious to one of ordinary skill in the art to modify the amount of pigment in order to obtain the best/desired color intensity. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. in view of Holderbaum et al. (US 6,007,828) and further in view of the teachings of Marchi-Lemann et al.

With respect to claims 61 and 62, Cohen et al. addresses all the limitations of claims 36, 51, 53 and 59, however fails to expressly disclose the other sunscreen being 4-methylbenzylidene camphor and isoamyl p-methoxycinnamate. Holderbaum et al. illustrates in Example 3, a formulation for sunblock comprising titanium dioxide, as well as 4-methylbenzylidene camphor and isoamyl p-methoxycinnamate (organic sunscreens). It would have been obvious to one of ordinary skill in the art to include 4-methylbenzylidene camphor and isoamyl p-methoxycinnamate with the titanium dioxide nanopigments of Cohen et al. in order to provide both UV-A and UV-B protection while reducing the whitening effect caused by high concentrations of titanium dioxide nanoparticles, as taught by Marchi-Lemann et al. (col. 1, lines 25-33).

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. in view of Purohit et al. (US 4,966,754).

With respect to claim 67, Cohen et al. addresses all the limitations of claims 36, 64 and 65, and further discloses using natural perfumes (essential oils) as preserving agents (col. 7, lines 37-39). Cohen et al. fails to expressly disclose the preserving agent selected from the group consisting of geraniol, linalool, neroli, vanillin, eugenol, methyleugenol, palmarosa oil and mixtures thereof. Purohit et al. discloses using natural perfumes (essential oils) as preserving agents in cosmetic compositions (col. 1,

lines 6-10). Purohit et al. also discloses the essential oils are selected from the group consisting of linalool, geraniol, neroli, eugenol and palmarosa oil (table in col. 2 – col. 3), and provides in Blend X (col. 3) a blend of oils used comprising linalool, geraniol and neroli. It would have been obvious to one of ordinary skill in the art to include natural perfumes disclosed in Purohit et al. as preserving agents in order to provide safe, mild and effective preservatives (col. 1, lines 37-40, 62-65).

Claim 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable Papantoniou et al. in view of Cargo Cosmetics ("Behind the Brand" article on [www.cargocosmetics.com](http://www.cargocosmetics.com)).

With respect to claims 71 and 72, Papantoniou et al. address all the limitations of claim 36, and further discloses the preparation is in the form of a paste, and when in the form of a paste, they are lip rouges or lip polishes (col. 6, lines 21-25). Papantoniou et al. fails to expressly disclose the preparation being introduced into a tube or pot. However, it is well known in the art that lip balms and lip glosses (equivalent to lip polish) are packaged in (introduced into) tubes or pots, such as tin pots (functionally equivalent to metal bowl), as demonstrated by Cargo Cosmetics. It would have been obvious design choice to one of ordinary skill in the art to modify the container that the preparation is introduced into in order to package the lip polish in packaging attractive to consumers.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Heger et al. (US 6,531,117) discloses sunblock having UV-A and UV-B filters, where the pigments are micronized.

Msika et al. (US 5,939,054) discloses a sunscreen composition using titanium dioxide having a particle size of  $20 \pm 5$  nm.

Nakajima et al. (US 6,348,200) discloses a lipid-bearing preparation for cosmetic uses, comprising an oil phase (oils and/or wax) and a solid phase (powder) (col. 23, lines 3-4, 42-43), wherein the oil phase comprises a mixture of vegetable-base raw materials, wherein the vegetable-base raw materials are selected from the group consisting of vegetable oils, vegetable waxes, and mixtures thereof (col. 23, lines 11, 13, 14, 36-37).

#### ***Telephone/Fax Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suez Ellis whose telephone number is (571) 272-2868. The examiner can normally be reached on 8:30am-5pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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